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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,146	09/08/2003	Xavier Blin	05725.1239-00	1368
22852 7590 06/14/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER ROGERS, JAMES WILLIAM	
			ART UNIT 1618	PAPER NUMBER
			MAIL DATE 06/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/656,146

Applicant(s)

BLIN ET AL.

Examiner

James W. Rogers, Ph.D.

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-117 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-117 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/19/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I in the reply filed on 05/08/2007 is acknowledged. The traversal is on the ground(s) that examination of all the claims would not impose a serious burden on the examiner since they are related to cosmetic compositions. The examiner upon review of the claims and the prior art has decided that indeed as applicants stated there would not be a serious burden to examine all of the claims since the additional elements in groups II and II (rheological agents and a particulate phase) are ordinary ingredients such as waxes and pigments added to cosmetic compositions. Therefore the examiner has withdrawn the previous restriction requirement and will examine all pending claims 1-117.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-22,24-26,60-81,83-110 and 112-117 are rejected under 35

U.S.C. 102(e) as being anticipated by Willemin et al. (US 6,592,855 B1).

Willemin teaches diphenyldimethicones as in formula 1 dissolved in non-volatile silicones such as phenyltrimethicone as in formula 2, the phenyltrimethicones have a viscosity between about 10 and 40 cSt (satisfying low viscosity) for making cosmetics or pharmaceuticals. See abstract, claims and col 2 lin 1-51. Regarding the limitations on the viscosity of the high viscosity phenyl siloxane, Willemin teaches the same phenylsiloxanes as claimed by applicants, when comparing the formula of claim 18 in applicants claims with formula 1 within Willemin they are within the other scope, therefore inherently the same polymer oil will have the same properties such as viscosity thus the limitations are met. The compositions also preferably contain a fatty body including fatty esters comprised of fatty acids and alcohols with 5-30 carbon atoms or just the fatty acids and alcohols on their own, the amount of fatty esters could be as high as 20% as shown in the examples. See col 3 lin 9-29 and examples. Regarding the limitations that the composition has an average gloss and a post-trial staying power within a certain amount, since the composition of Willemin comprises the same ingredients as applicants it inherently meets the above limitations because the same composition will have the same properties. It appears as though applicants are claiming a new or undiscovered property of an old composition. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ

Art Unit: 1618

430, 433 (CCPA 1977). The amount of the phenylsilicones above can comprise from 0.1 to 100% of the fatty phase of the invention and diphenyldimethicone can be from about 0.1 to about 20% of the siloxane solution, thus the ratio of the low viscosity phenyltrimethicone and the high viscosity diphenyldimethicone can be as high as 8/2 (80%/20%) within applicants claimed ratio. See col 2 lin 52-67. From the amount of the low and high viscosity siloxanes above in the fatty phase applicants claimed concentration amounts are met by the disclosure of Willemin. Willemin also teaches the use of pigments and pearlescents within applicants claimed amount for particulate phase eg pigments, fillers and nacles. See examples. The compositions within Willemin had many disclosed uses including cosmetic formulations for dermatological applications or hair compositions in any form conceivable including gel, cream, lotion or solid forms including rods or sticks; example 1 describes a lipstick. See col 4 lin 53-60 and examples.

Claims 1-13,18-19,24-39,44-45,50-72,77-78,83-101,106-107 and 112-117 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnaud (US 2001/0031269 A1).

Arnaud teaches cosmetic compositions comprising 0.5 to 90% non-volatile silicone compound (including numerous phenyl siloxanes that would meet applicants claimed formula) and 5 to 90% of non-volatile hydrocarbon based oil including diisostearate malate, diglycerol diisostearate and diglycerol triisostearate. See abstr, [0056],[0057],[0080]-[0084]. Regarding the limitations that the composition has an average gloss and a post-trial staying power within a certain amount, since the composition of Arnaud comprises the same ingredients as applicants it inherently meets

the above limitations because the same composition will have the same properties. It appears as though applicants are claiming a new or undiscovered property of an old composition. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Regarding the limitations on the viscosity of the high viscosity phenyl siloxane, Arnaud teaches the same phenylsiloxanes as claimed by applicants, therefore inherently the same polymer oil will have the same properties such as viscosity, thus the limitations are met. Arnaud also teaches the use of 0-50% by weight of waxes including polyethylene waxes, microcrystalline waxes, ect and silicone waxes with pendent chains of alkyl and alkoxy type containing 8 to 24 carbons. See col [0108]-[0110]. Arnaud also teaches that the waxes can be used in mixtures with each other. The compositions of Arnaud can further comprise from 0-70 % by weight of fillers and pigments, thus satisfying the limitation for a particulate phase. The compositions of Arnaud had numerous cosmetic uses but were preferably a lipstick composition. See [0115]-[0116].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willemin et al. (US 6,592,855 B1) in view of Arnaud (US 2001/0031269 A1).

Willemin is disclosed above. Willemin as disclosed above teaches that the amount of diphenyldimethicones can be up to 20% in a mixture with the low viscosity solvating phenylsiloxane, meeting applicants claimed ratio of 10/1 and 10/2 in claims 21 and 22. However it would have been obvious to one of ordinary skill in the art that the

amounts disclosed within Willemin are not the only concentrations contemplated because the reference clearly states that the proportion between the diphenyldimethicone silicone gum and the solubilizing phenyltrimethicone silicone oil can vary within wide limits. Thus from the above disclosure it would be an obvious open invitation to one of ordinary skill in the art to vary the proportions of the phenylsiloxanes over a wide range through routine experimental practice in order to arrive at the desired properties and/or consistency of the composition.

Willemin while disclosing the use of waxes in the cosmetic examples does not disclose the use of silicone waxes as claimed by applicants.

Arnaud is disclosed above. Arnaud is used primarily for the disclosure within that it was already well known in the art at the time of the invention to include mixtures of waxes including silicone waxes in cosmetic compositions.

It would have been prime facie obvious at the time of the invention to a person of ordinary skill in the art to modify the siloxane containing cosmetic compositions disclosed in Willemin and add the waxes disclosed within Arnaud. It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. One with ordinary skill in the art would also have been motivated and would have a reasonably high expectation of success in combining the waxes of Arnaud with Willemin in order to arrive at the desired



mechanical and texture quality for the cosmetic. See [0111] in Arnaud. As shown by the recited teachings, instant claims are no more than the combination of conventional components of siloxane containing cosmetic compositions. It therefore follows that the instant claims define prime facie obvious subject matter.

### **Conclusion**

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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